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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/617,865	07/14/2003	Noboru Masuda	33216M0381	3830
441	7590	06/16/2005	EXAMINER	
SMITH, GAMBRELL & RUSSELL, LLP 1850 M STREET, N.W., SUITE 800 WASHINGTON, DC 20036			PARKER, FREDERICK JOHN	
			ART UNIT	PAPER NUMBER
			1762	
DATE MAILED: 06/16/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/617,865

Applicant(s)

MASUDA ET AL.

Examiner

Frederick J. Parker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 5-3-05.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 24,25,31-34 and 36-48 is/are pending in the application.
- 4a) Of the above claim(s) 24,25,31-33,36,37 and 39-48 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 34,38 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

Claim Objections

The amendments in response to the Claim Objections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the objections.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 34 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Neither original claims nor specification provide any support for steps (i) and (ii) as currently worded. They are in fact contrary to the original filing, see for example, but not limited to, page 4, full paragraphs 2-3; page 5, full paragraph 2; etc. Applicants also failed to provide page – line citations to support the new limitations deemed New Matter.

1. The amendments in response to the 35 USC 112/ Second Paragraph rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections. The new rejections are necessitated by amendment.

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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3. Claims 34,38 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 34 is vague and indefinite because in (i) it is unclear how discharging paint to the return side (for which earlier in the claim is established a nexus between discharge and stopping the paint on line 4) to stop the paint is carried out by a time the coating means is feeding paint to the nozzle to start coating since feeding paint to discharge stops paint whereas feeding paint to the nozzle causes paint coating, causing a contradiction; similarly (ii) appears to simultaneous feed and stop paint which is contradictory.
- Claim 38 is vague and indefinite because it is unclear how the two-way valve is related to the steps (i)-(iii).

Claim Rejections - 35 USC § 102

The amendments in response to the 35 USC 102 rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections.

Claim Rejections - 35 USC § 103

The amendments in response to the 35 USC 103 rejections of the Previous Office Action are acknowledged and appreciated, and the Examiner withdraws the rejections.

4. Claims 34 and 38 distinguish over the prior art which does not teach nor suggest the contradictory steps of (i) starting paint discharge to the return (stop) side by a time that feeding paint to the nozzle starts coating, and (ii) stops discharging paint to the return side while continuing to feed paint to the nozzle for coating. It is only for these reasons the claims distinguish over the prior art. Both claims are rejected under 35 USC 112 above.

Response to Arguments

The Examiner has considered Applicants arguments. Those directed to newly amended claims are dealt with in the rejections above. The Examiner responds to those remaining.

On page 10, Applicants argue Applicants method prevents swelling at the coating start. It is noted this limitation is nowhere required by the previous or current versions of the claims, so argument is not commensurate with scope of claims. Furthermore, the Examiner points out Iwashita does not state nor show in the figures any of the swelling argued by Applicants, which would account for why they don't deal with end swelling. Clearly if the reference is to "ensure that the end of the coating is distinct" (as stated by Applicants in their Response, page 10\ line 10), that would at least reasonably imply no swelling exists because that would cause an indistinct end. The Examiner maintains that Iwashita taught each and every limitation if the claim as previously worded.

Applicants have amended claim 38 to depend on claim 34 and therefore the previous rejection of claim 38 is moot. Applicants are reminded neither claim is allowable because of rejections under 35 USC 112 above.

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

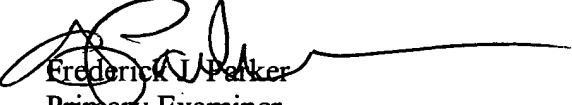
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frederick J. Parker whose telephone number is 571/ 272-1426. The examiner can normally be reached on Mon-Thur. 6:15am -3:45pm, and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on 571/272-1423. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Frederick J. Parker
Primary Examiner
Art Unit 1762

fjp